

R E M A R K S

Information Disclosure Statement

The Examiner is respectfully requested to return a copy of the IDS Form filed on July 31, 2009, with the Examiner's initials in the left column next to the cited publication, to indicate that the cited publication was considered and made of record.

Telephone Interview With the Examiner

The undersigned had a telephone interview with Examiner Vu on August 10, 2009 to clarify the 35 USC 103 rejection set forth in the August 6, 2009 Office Action. Examiner Vu said during said telephone interview that claims 1 to 7 were intended to be rejected over Morishima et al. (WO 02/22131) in view of Koide et al. (JP 7-33650).

Claim Amendments and New Claims

Claims 1 to 7 were canceled hereinabove and were replaced with new claims 10 to 13.

The recitation in new claim 10 of "a prostaglandin F2 α derivative having a fluorine atom or fluorine atoms in the

molecule" is supported on page 5, lines 10 to 20 of the present specification.

The recitation in new claim 10 of "a resin container formed from a polymer alloy of polyethylene terephthalate and polyarylate, wherein a component ratio of polyethylene terephthalate/polyarylate is 1/2 to 2/1" is supported in the specification on page 7, line 1 to page 8, line 4.

New claim 10 also includes features of original claim 1.

New claim 11 recites the feature of original claim 3.

New claims 12 and 13 are supported by the paragraph bridging pages 5 and 6 of the present specification.

Rejection Under 35 USC 112, Second Paragraph

Claims 1 to 3 were rejected under 35 USC 112, second paragraph, for the reasons set forth on pages 2 to 3 of the August 4, 2009 Office Action.

The Examiner took the position that the terminology of "prostaglandin derivative" and "prostaglandin F2 α derivative" in the claims is indefinite.

Claims 1 to 3 were canceled hereinabove.

It is respectfully submitted that the new claims 10 to 13 are free of the 35 USC 112, second paragraph rejection.

Withdrawal of the 35 USC 112, second paragraph rejection is respectfully requested.

Obviousness Rejection Under 35 USC 103

Claims 1 to 7 were rejected under 35 USC 103 as being unpatentable over Morishima et al. (WO 02/22131) in view of Koide et al. (JP 7-33650). It was stated in the Office Action that US 2004/0097592 was used by the Examiner as an English-language translation for Morishima. The reasons for this rejection are set forth on pages 3 to 5 of the Office Action.

It was admitted in the Office Action that Morishima et al. do not specifically teach a resin container containing a copolymer of polyethylene terephthalate and polyarylate with a ratio of 1:4 to 4:1.

It was also admitted in the Office Action that the references do not specifically teach adding the ingredients in a ratio amount as claimed by the applicants.

It is noted that applicants' present claims recite a resin container containing a polymer alloy of polyethylene

terephthalate and polyarylate, wherein a ratio of polyethylene terephthalate/polyarylate is 1/2 to 2/1.

Applicants' present claims are directed to a prostaglandin-containing product, wherein a aqueous liquid preparation containing a prostaglandin F2 α derivative having a fluorine atom or fluorine atoms in a molecule is stored in a resin container formed from a polymer alloy of polyethylene terephthalate and polyarylate of which the component ratio of polyethylene terephthalate/polyarylate is 1/2 to 2/1, thereby inhibiting the decrease of the content of the prostaglandin F2 α derivative in the aqueous liquid preparation.

Table 1 on page 13 of the present specification demonstrates that the storage stability of a prostaglandin F2 α derivative having a fluorine atom or fluorine atoms in a molecule is significantly better when stored in a resin container formed from a polymer alloy of polyethylene terephthalate and polyarylate, wherein the component ratio of polyethylene terephthalate /polyarylate is 1/2 to 2/1 (Example 1) in comparison with the cases in which the prostaglandin F2 α derivative is stored in any of a polyethylene container, a polypropylene container and a polyethylene terephthalate container (Comparative Examples 1 to 3).

Applicants' Table 1 is reproduced as follows:

Table 1

	Material of the container	Content of the present compound (%)
Example 1	PET/PAR* ¹	97.0
Comparative Example 1	LDPE* ²	83.1
Comparative Example 2	PP* ³	91.0
Comparative Example 3	PET* ⁴	91.8

*¹: U-8000 (manufactured by Unitika Ltd.)

*²: Petrocene 175K (manufactured by Tosoh Corporation)

*³: J-225W (manufactured by Mitsui Chemicals, Inc.)

*⁴: PIFG5H (manufactured by Kanebo Gohsen, ltd.)

In contrast to the presently claimed invention, Morishima et al. (WO 02/22131) relate to an ophthalmic solution comprising a prostaglandin derivative and describe that adsorption of prostaglandin derivatives to a resin container can be inhibited by adding a nonionic surfactant, such as polysorbate 80, and an antioxidant, such as disodium ethylenediaminetetraacetate, to the ophthalmic solution comprising a prostaglandin derivative.

Although Morishima et al. and the presently claimed invention are common in that they both aim to inhibit the

adsorption of a prostaglandin derivative to a container, an essential component in Morishima et al. is a nonionic surfactant or an antioxidant, whereas a container containing a polymer alloy of polyethylene terephthalate and polyarylate is recited in applicants' claims.

Furthermore, Morishima et al. do not teach or suggest that a resin container formed from a polymer alloy of polyethylene terephthalate and polyarylate exhibits an excellent storage stability (absorption inhibition effect) of a prostaglandin F2 α derivative having a fluorine atom or fluorine atoms in a molecule.

It is therefore respectfully submitted that the presently claimed invention is substantially different from Morishima et al.

Koide et al. (JP 7-33650) relate to an aqueous eye drop solubilizing vitamin As obtained by filling an aqueous solution containing vitamin As in a container made of polyethylene terephthalate, containing a pigment or pigments and a U-polymer (polyarylate), capable of shielding light at a wavelength of $\leq 380\text{nm}$ to inhibit the migration of vitamin As, which is very unstable in light, thereby improving the residual ratio of the

vitamin As therein (paragraph [0002]; Examples 1 to 8 of Koide et al.)

Koide et al. describe in paragraph [0008] that the fourth essential constituent of Koide et al. is a pigment which may have a high light shielding effect, such as tinuvin or anthraquinone yellow dye, and when the light shielding wavelength is less than 380nm, even after the addition of the pigment, the vitamin As therein decreases significantly after a long period.

Koide et al. and the presently claimed invention differ in that a pigment with a high light shielding effect is an essential component of Koide et al., while it is not required in the presently claimed invention. Accordingly, as is clear from Table 2 of Koide et al., although Comparative Example 4 includes polyethylene terephthalate and a U-polymer as a material of a container, the concentration (residual ratio) of Vitamin As is merely 26%. Considering that Koide et al. describe the comparison as an example, wherein no stabilizing effect of Vitamin As is exhibited, Koide et al. would not lead a person of ordinary skill in the art to arrive at the presently claimed invention which, employs a prostaglandin F2 α derivative having a

fluorine atom or fluorine atoms in a molecule, rather than Vitamin As.

Neither Morishima et al. nor Koide et al. describe that the storage stability of a prostaglandin F2 α derivative having a fluorine atom or fluorine atoms in a molecule is significantly better when stored in a resin container formed from a polymer alloy of polyethylene terephthalate and polyarylate of which the component ratio of polyethylene terephthalate/polyarylate is 1/2 to 2/1, as recited in applicants' claims.

It is respectfully submitted that one of ordinary skill in the art would therefore not consider to combine Morishima et al. and Koide et al. to attempt to arrive at the presently claimed invention. Even assuming *arguendo* that the references were combinable, such combination would not lead to the presently claimed invention.

Withdrawal of the 35 USC 103 rejection is therefore respectfully requested.

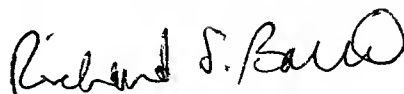
Reconsideration is requested. Allowance is solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the

undersigned at the telephone number given below for prompt
action.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard S. Barth", is written over a horizontal line.

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